

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE**

\_\_\_\_\_X  
In re Application of: Hermkens *et al.* : Examiner: **Patricia Morris**  
Patent For: :  
**INDOLES USEFUL IN THE**  
**TREATMENT OF ANDROGEN-**  
**RECEPTOR RELATED DISEASES** : Group Art Unit: **1625**  
: :  
Serial No. **10/534,945** : :  
: : Confirmation No.: **1701**  
Filed: **May 7, 2005** : :  
: :  
\_\_\_\_\_X

Commissioner for Patents  
P.O. Box 1450  
Alexandria, Virginia 22313-1450

**Request for Reconsideration of Patent Term Adjustment**

**Under 37 C.F.R. §1.705(d)**

Sir:

In response to the ISSUE NOTIFICATION, mailed on August 26, 2010, Applicants respectfully request reconsideration of the Patent Term Adjustment of **956 days** noted on the Notice, and request that it be corrected to **953 days**. This request is filed within two months of the issue date of the patent, September 14, 2010, and is therefore timely.

Applicants hereby authorize the payment of any fees associated with this Request (e.g., the fee set forth in 37 C.F.R. §1.18(e)) to be drawn from Applicants' deposit account No. **No. 50-4205**.

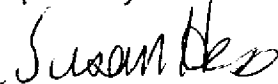
Applicants respectfully submit that a Patent Term Adjustment of 953 days should be accorded to this application. In support thereof, Applicants have attached a copy of the "patentterm® AIPA Term Calculation Report" which summarizes the prosecution history of the present application, the grounds for adjustment under 37 C.F.R. § 1.702

applied to the prosecution history, and corresponding period of adjustment due under 37 C.F.R. §1.703.

It can be seen that Applicants' calculation of the Patent Term Adjustment (PTA) is different from the PTA calculated by the PTO. The priority date of the present application is May 7, 2005. As the expiration of the 30-month period pursuant to 35 U.S.C. §371(b) fell on Saturday, the 30-month period expired on the subsequent business day. (See PCT Rule 80.5). Accordingly, the commencement date is Monday, May 9, 2008. In view of the 30 month date beginning on May 9, 2008 it is submitted that under the 3-Year Rule the number of credit days is 562 days and under the 14-Month PTO First Action Rule the number of credit days is 572 days.

In view of the AIPA Term Calculation Report, it is believed that the PTA should be 953 days. Review of the calculation and grant of 953 days PTA is respectfully requested.

Respectfully submitted,

  
Susan L. Hess  
Reg. No. 37, 350

Merck & Co., Inc.  
Patent Department  
Mail Stop K-6-1, 1990  
2000 Galloping Hill Road  
Kenilworth, NJ 07033-0530

Phone: (908) 298-2161  
Fax: (908) 298-5388

114201\_1.DOC

## AIPA Term Calculation Report

APPLICATION INFORMATION			
Docket Number:	0-2002.723 US	User Name:	Hess, Susan
Application Number:	10/534,945	Firm/Company Name:	Organon, a part of Schering-Plough
Filing Date:	11/03/2003	User Comments:	
Title/Inventor(s):	INDOLES USEFUL IN THE TREATMENT OF ANDROGEN-RECEPTOR RELATED DISEASES; Pedro Harold Han Herinkens, Oss, (NL)		
	Calculation Generated:	11/10/2010 01:59:34 PM ET	

AIPA TERM CALCULATION SUMMARY	
Earliest Referenced Application under 35 USC § 120, 121, or 365(c):	11 / 03 / 2003
International Filing Date:	11 / 03 / 2003
Net Adjustment Credits:	1134 Days
Net Adjustment Debits:	181 Days
Patent Term Adjustment:	953 Days
AIPA Patent Term End Date:	06 / 13 / 2026 (1)
(1) Assumes payment of all maintenance fees, no intervening acts, and no 35 USC 156 regulatory extensions. Terminal disclaimer(s) filed in this case, if any, may result in an earlier term end date. Without adjustment, the term would end on 11/03/2023.	

COMPARISON TO USPTO PAIR PTA TAB (2) (Based on PAIR Data from 11/10/2010)			
	PAIR PTA Tab	Your Calculation	Comparison
Credit Days (USPTO Delay):	1137	1134	X
Debit Days (Applicant Delay):	181	181	March
Total Patent Term Adjustment Days:	956	953	X
(2) Comparison is shown for Non-Q's entering USPTO Delays, Applicant Delays, and Total PTA Adjustments (field) from USPTO PAIR Patent Term Adjustments (PTA) tab on 11/10/2010. See the full PAIR PTA tab, file wrapper (e.g., Notice of Allowance, PTA petitions), and issued patent for complete information on USPTO-calculated PTA.			

RULE CALCULATION SUMMARY (3)						
Event	Rule Invoked	Related Event	Exclusion Days (4)	Debit Days (5)	Credit Days (6)	
<b>A</b> 05/09/2005 National Stage Commenced under 35 USC 371(b) or (f)	<b>3-Year PTO Issue of Patent</b>  PTO must issue a patent within 3 years (not including exclusions) after the date on which the application was filed under 35 USC 111(a) or the national stage commenced under 35 USC 371(b) or (f) in an international application. Period of adjustment (credits) begins on the day after the date that is 3 years after the date on which the application was filed under 35 U.S.C. 111(a) or the national stage commenced under 35 USC 371(b) or (f) in an international application and ending on the date a patent was issued, but not including the sum of the listed exclusionary periods. 35 USC 154(b)(1)(B); 37 CFR 1.702(b), 1.703(b).	<i>Issue Date:</i> 09/14/2010 Issue Date			562	
<b>B</b> 05/09/2005 Application Fulfilled Requirements of 35 USC 371	<b>14-Month PTO First Action</b>  PTO must mail a notification under 35 USC 132 or a notice of allowance under 35 USC 151 not later than 14 months after the date on which the application was filed under 35 USC 111(a) or fulfilled the requirements of 35 USC 371 in an international application. Period of adjustment (credits) begins on the day after the date that is 14 months after the date on which the application was filed under 35 USC 111(a) or fulfilled the requirements of 35 USC 371 and ending on the date of mailing of either an action under 35 USC 132, or a notice of allowance under 35 USC 151, whichever occurs first. 35 USC 154(b)(1)(A)(i); 37 CFR 1.702(a)(1), 1.703(a)(1).	<i>First PTO Action:</i> 02/01/2008 Restriction / Election-of-Species			572	
<b>C</b> 02/01/2008 Restriction / Election-of-Species	<b>3-Month Applicant Response to Notice of Action</b>  Period of adjustment (credits) shall be reduced for the period in excess of 3 months taken to reply to any PTO notice or action making any rejection, objection, argument, or other request, beginning on the day after the date that is 3 months after the date of mailing or transmission of the Office communication and ending on the date the reply was filed. The period, or shortened statutory period, for reply set in the action or notice has no effect on this deadline. 35 USC 154 (b)(2)(C)(i); 37 CFR 1.704(b).  Where applicant shows, in spite of all due care, applicant was unable to respond within the 3-month period, all or part of adjustment may be reinstated for up to 3 additional months. 35 USC 154(b)(3)(C); 37 CFR 1.705(c).  You have indicated that no 1.705(c) Showing of Due Care was made.	<i>Applicant Response:</i> 02/28/2008 Response to Election-of-Species / Restriction Filed		0		

<p><b>D</b></p> <p>02/28/2008 Response to Election-of-Species/ Restriction Filed</p>	<p><u><b>4-Month PTO Response to Applicant Reply</b></u></p> <p>PTO must respond to a reply under 35 USC 132 not later than 4 months after the date on which the reply was filed. The period of adjustment (credits) begins on the day after the date that is 4 months after the date a reply under 37 CFR 1.111 or in compliance with 37 CFR 1.113(c) was filed and ending on the mailing date of either an action under 35 USC 132, or a notice of allowance under 35 USC 151, whichever occurs first. 35 USC 154(b)(1)(A)(ii); 37 CFR 1.702(a)(2), 1.703(a)(2),(3).</p>	<p><i>PTO Response:</i></p> <p>06/03/2008 Non-final Action</p>			<p>0</p>
<p><b>E</b></p> <p>06/03/2008 Non-final Action</p>	<p><u><b>3-Month Applicant Response to Notice of Action</b></u></p> <p>Period of adjustment (credits) shall be reduced for the period in excess of 3 months taken to reply to any PTO notice or action making any rejection, objection, argument, or other request, beginning on the day after the date that is 3 months after the date of mailing or transmission of the Office communication and ending on the date the reply was filed. The period, or shortened statutory period, for reply set in the action or notice has no effect on this deadline. 35 USC 154 (b)(2)(C)(ii); 37 CFR 1.704(b).</p> <p>Where applicant shows, in spite of all due care, applicant was unable to respond within the 3-month period, all or part of adjustment may be reinstated for up to 3 additional months. 35 USC 154(b)(3)(C); 37 CFR 1.705(c).</p> <p>You have indicated that no 1.705(c) Showing of Due Care was made.</p>	<p><i>Applicant Response:</i></p> <p>12/02/2008 Reply after Non-final Action under 37 CFR 1.111</p>		<p>90</p>	
<p><b>F</b></p> <p>12/02/2008 Reply after Non-final Action under 37 CFR 1.111</p>	<p><u><b>4-Month PTO Response to Applicant Reply</b></u></p> <p>PTO must respond to a reply under 35 USC 132 not later than 4 months after the date on which the reply was filed. The period of adjustment (credits) begins on the day after the date that is 4 months after the date a reply under 37 CFR 1.111 or in compliance with 37 CFR 1.113(c) was filed and ending on the mailing date of either an action under 35 USC 132, or a notice of allowance under 35 USC 151, whichever occurs first. 35 USC 154(b)(1)(A)(ii); 37 CFR 1.702(a)(2), 1.703(a)(2),(3).</p>	<p><i>PTO Response:</i></p> <p>02/27/2009 Final Rejection</p>			<p>0</p>
<p><b>G</b></p> <p>02/27/2009 Final Rejection</p>	<p><u><b>3-Month Applicant Response to Notice of Action</b></u></p> <p>Period of adjustment (credits) shall be reduced for the period in excess of 3 months taken to reply to any PTO notice or action making any rejection, objection, argument, or other request, beginning on the day after the date that is 3 months after the date of mailing or transmission of the Office communication and ending on the date the reply was filed. The period, or shortened statutory period, for reply set in the action or notice has no effect on this deadline. 35 USC 154 (b)(2)(C)(ii); 37 CFR 1.704(b).</p> <p>Where applicant shows, in spite of all due care, applicant was unable to respond within the 3-month period, all or part of adjustment may be reinstated for up to 3 additional months. 35 USC 154(b)(3)(C); 37 CFR 1.705(c).</p> <p>You have indicated that no 1.705(c) Showing of Due Care was made.</p>	<p><i>Applicant Response:</i></p> <p>08/26/2009 Notice of Appeal to Board of Patent Appeal and Interferences</p>		<p>91</p>	

<p><b>H</b></p> <p>08/26/2009 Notice of Appeal to Board of Patent Appeal and Interferences</p>	<p><u><b>Exclusion for Appellate Review</b></u></p> <p>3-Year PTO Issue Requirement does not include the period of appellate review by the BPAI or a Federal court, beginning on the date on which a notice of appeal to the BPAI was filed under 35 USC 134 and 37 CFR 41.31 and ending on the date of the last decision by the BPAI or by a Federal court in an appeal under 35 USC 141 or a civil action under 35 USC 145, or on the date of mailing of either an action under 35 U.S.C. 132, or a notice of allowance under 35 U.S.C. 151, whichever occurs first, if the appeal did not result in a decision by the BPAI. 35 USC 154(b)(1)(B)(ii); 37 CFR 1.702(b)(4), 1.703(b)(4).</p>	<p><i>Responsive Event</i></p> <p>09/08/2009 Notice of Allowance under 35 USC 151</p>	<p>14</p>		
<p><b>I</b></p> <p>09/08/2009 Notice of Allowance under 35 USC 151</p>	<p><u><b>3-Month Applicant Response to Notice of Action</b></u></p> <p>Period of adjustment (credits) shall be reduced for the period in excess of 3 months taken to reply to any PTO notice or action making any rejection, objection, argument, or other request, beginning on the day after the date that is 3 months after the date of mailing or transmission of the Office communication and ending on the date the reply was filed. The period, or shortened statutory period, for reply set in the action or notice has no effect on this deadline. 35 USC 154 (b)(2)(C)(ii); 37 CFR 1.704(b).</p> <p>Where applicant shows, in spite of all due care, applicant was unable to respond within the 3-month period, all or part of adjustment may be reinstated for up to 3 additional months. 35 USC 154(b)(3)(C); 37 CFR 1.705(c).</p> <p>You have indicated that no 1.705(c) Showing of Due Care was made.</p>	<p><i>Applicant Response</i></p> <p>12/07/2009 Request for Continued Examination under 35 U.S.C. 132(b)</p>	<p>0</p>		
<p><b>J</b></p> <p>12/07/2009 Request for Continued Examination under 35 U.S.C. 132(b)</p>	<p><u><b>Exclusion for Continued Examination</b></u></p> <p>3-Year PTO Issue Requirement does not include the period consumed by continued examination of the application under 35 USC 132(b), beginning on the date on which a request for continued examination of the application under 35 USC 132(b) was filed and ending on the date the patent was issued. 35 USC 154(b)(1)(B)(i); 37 CFR 1.702(b)(1), 1.703(b)(1).</p>	<p><i>Issue Date</i></p> <p>09/14/2010 Issue Date</p>	<p>282</p>		
<p><b>K</b></p> <p>02/19/2010 Notice of Allowance under 35 USC 151</p>	<p><u><b>3-Month Applicant Response to Notice of Action</b></u></p> <p>Period of adjustment (credits) shall be reduced for the period in excess of 3 months taken to reply to any PTO notice or action making any rejection, objection, argument, or other request, beginning on the day after the date that is 3 months after the date of mailing or transmission of the Office communication and ending on the date the reply was filed. The period, or shortened statutory period, for reply set in the action or notice has no effect on this deadline. 35 USC 154 (b)(2)(C)(ii); 37 CFR 1.704(b).</p> <p>Where applicant shows, in spite of all due care, applicant was unable to respond within the 3-month period, all or part of adjustment may be reinstated for up to 3 additional months. 35 USC 154(b)(3)(C); 37 CFR 1.705(c).</p> <p>You have indicated that no 1.705(c) Showing of Due Care was made.</p>	<p><i>Applicant Response</i></p> <p>04/09/2010 Request for Continued Examination under 35 U.S.C. 132(b)</p>	<p>0</p>		

<b>Exclusion for Continued Examination</b>				
<b>L</b>	04/09/2010 Request for Continued Examination under 35 U.S.C. 132(b)	3-Year PTO Issue Requirement does not include the period consumed by continued examination of the application under 35 USC 132(b), beginning on the date on which a request for continued examination of the application under 35 USC 132(b) was filed and ending on the date the patent was issued. 35 USC 154(b)(1)(B)(i); 37 CFR 1.702(b)(1), 1.703(b)(1).	<i>Issue Date:</i> 09/14/2010 Issue Date	159
<b>M</b>	05/04/2010 Notice of Allowance under 35 USC 151	<b>3-Month Applicant Response to Notice or Action</b>  Period of adjustment (credits) shall be reduced for the period in excess of 3 months taken to reply to any PTO notice or action making any rejection, objection, argument, or other request, beginning on the day after the date that is 3 months after the date of mailing or transmission of the Office communication and ending on the date the reply was filed. The period, or shortened statutory period, for reply set in the action or notice has no effect on this deadline. 35 USC 154 (b)(2)(C)(ii); 37 CFR 1.704(b).  Where applicant shows, in spite of all due care, applicant was unable to respond within the 3-month period, all or part of adjustment may be reinstated for up to 3 additional months. 35 USC 154(b)(3)(C); 37 CFR 1.705(c).  You have indicated that no 1.705(c) Showing of Due Care was made.	<i>Applicant Response:</i> 08/04/2010 Issue Fee Payment under 35 USC 151	0
<b>N</b>	08/04/2010 Issue Fee Payment under 35 USC 151	<b>4-Month PTO Issue of Patent</b>  PTO must issue a patent not later than 4 months after the date on which the issue fee was paid under 35 USC 151 and all outstanding requirements were satisfied. The period of adjustment (credits) begins on the day after the date that is 4 months after the date the issue fee was paid and all outstanding requirements were satisfied and ends on the day the patent issues. 35 USC 154(b)(1)(A)(iv); 37 CFR 1.702(a)(4), 1.703(a)(6).	<i>Issue Date:</i> 09/14/2010 Issue Date	0
<b>Total Exclusion, Debit, and Credit Days:</b>				
<b>Overlap Days (7) :</b>		455	181	1134
<b>Net Exclusion, Debit, and Credit Days:</b>		159	0	0
<b>Patent Term Adjustment Days (8) :</b>		296	181	1134
				953

(3) Calculations of Debit, Credit, and Exclusion Days are determined by the rule assignments, assignments of related events, and analysis options in the Apply Term Rules tab. The patent professional using this system is responsible for reviewing and updating the Apply Term Rules tab to ensure all data is complete, correct, and consistent with their judgment and interpretation of applicable legal authority.

(4) Exclusion Days are periods which are not included in determining the end of the 3-year period after the date on which the application was filed under 35 USC 11(a), or the national stage commenced under 35 USC 371(b) or (f) in an international application, used to determine credits under the 3-Year PTO Issue of Patent rule. See 35 USC 154(b)(1)(B)(i); 37 CFR 1.702(b)(1)(i); 1.703(b)(1)(i).

(5) Debit Days are days where grounds for reduction of period of adjustment of patent term exist. See, e.g., 37 CFR 1.704. Debit Days are sometimes referred to as Applicant Delay.

(6) Credit Days are days where grounds for adjustment of patent term exist. See, e.g., 37 CFR 1.702, 1.703. Credit Days are sometimes referred to as USPTO Delay.

(7) To the extent credit periods overlap other credit periods, debit periods overlap other debit periods, or exclusion periods overlap other exclusion periods, overlaps are subtracted so that each calendar day generates at most one credit day, one debit day, and one exclusion day.

(8) Patent Term Adjustment Days equals Net Credit Days minus Net Debit Days, but is not less than zero.